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10/623,957

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Wesley D. Johnson

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MAGINOT, MOORE & BECK, LLP
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111 MONUMENT CIRCLE
SUITE 3250
INDIANAPOLIS, IN 46204

EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

07/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding:

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/623,957

Applicant(s)

JOHNSON ET AL.

Examiner

David Comstock

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 192-197 and 209-224 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 212-224 is/are allowed.
- 6) ☒ Claim(s) 192-197, 209 and 210 is/are rejected.
- 7) ☒ Claim(s) 211 and 225 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/16/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

The priority information in the first sentence of the Specification (as updated in the Preliminary Amendment filed 21 July 2003) requires further updating to reflect that parent application 09/872,905 has matured into U.S. Pat. No. 6,595,998.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 192-195, 209 and 210 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumgartner (5,702,454).

Baumgartner discloses a method of accessing an intradiscal space 5 via an elongated access channel 6 and providing an expandable structure comprising at least a top element 7, a bottom element 7 and a plurality of intermediate elements 7 through the channel to the intradiscal space (see, e.g., Figs. 1 and 2). A top element is configured to contact the upper vertebral body 2, a bottom element is configured to contact the lower vertebral body 1, and intermediate elements are configured to reside between top and bottom elements. The intermediate elements are introduced consecutively and individually into the central intervertebral space, such that as each

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slides between top and bottom elements, top and bottom elements move apart to support (and distract) the vertebrae. The elements 7 may be considered to be configured for interlocking coupling via ducts 14 and a common support 20 (see, e.g., Fig. 6 and col. 5, lines 22-33). Top, bottom and intermediate elements may have different dimensions (see, e.g., col. 2, lines 8 and 9). The elements may comprise solid, rigid elements (see, e.g., col. 2, lines 12-14). The elements are formed of "implant materials" such as, for example, polyurethane and/or hydrogel (see, e.g., col. 2, lines 51-57). The space is accessed by a posterior or posterior lateral approach (see, e.g., Fig. 1). The sloping, spherical upper surfaces of the elements act as lifting surfaces to other elements thereagainst.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 196 and 197 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner (5,702,454).

Baumgartner discloses that the elements may have different dimensions but does not explicitly recite that top or bottom elements have a greater area than the intermediate elements. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the differently sized

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elements in locations such that top or bottom elements are larger than the intermediate elements, since it has been held that mere relocation of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Moreover, it is noted that a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Allowable Subject Matter

Claims 212-224 are allowed.

Claims 211 and 225 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 16 April 2007 have been fully considered but they are not persuasive with respect to the rejected claims.

In response to Applicant's argument regarding the manner of insertion of the elements of the device of Baumgartner, it is noted that an uppermost element can be considered a top element, a lowermost element, a bottom element, and elements therebetween and around, intermediate elements. However, the separation or movement of the elements is not confined to the axis of the spine. For this reason, new claim 225 has not been rejected. It is also noted that the elements can be seen as

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interlocking by cooperation with support 20, since the claims do not preclude the presence of the additional structure.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER